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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/932,171

08/17/2001

John R. Firth

258/188

4672

34313

7590

03/17/2008

ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT

4 PARK PLAZA

SUITE 1600

IRVINE, CA 92614-2558

EXAMINER

MENDEZ, MANUEL A

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/932,171	<b>Applicant(s)</b> FIRTH ET AL.	
	<b>Examiner</b> Manuel A. Mendez	<b>Art Unit</b> 3763	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/17/2001 and 03/29/2004</u> .                               | 6) <input type="checkbox"/> Other: ____.                          |

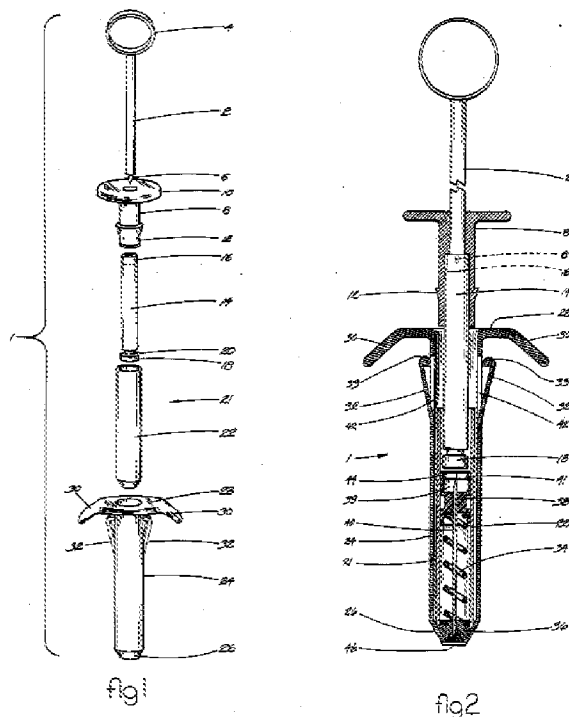
## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

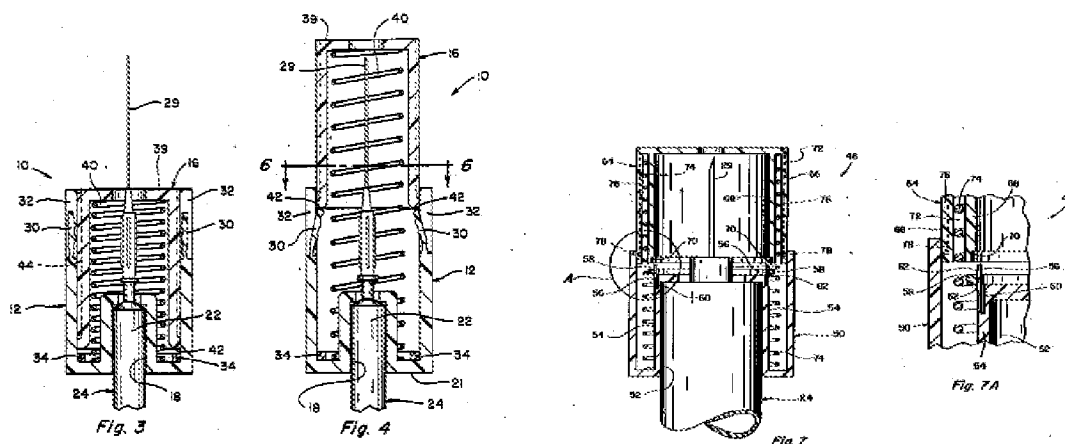
**Claims 6-25 and 26-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haber et al. (4,767,413)** in view of **Sudnak (4,894,055)** or **Carrell et al. (4,846,796)**.



The Haber et al. patent shows in figures 1 and 2, a disposable syringe device comprising an elongate body having a cavity therein for receiving a medicine cartridge,

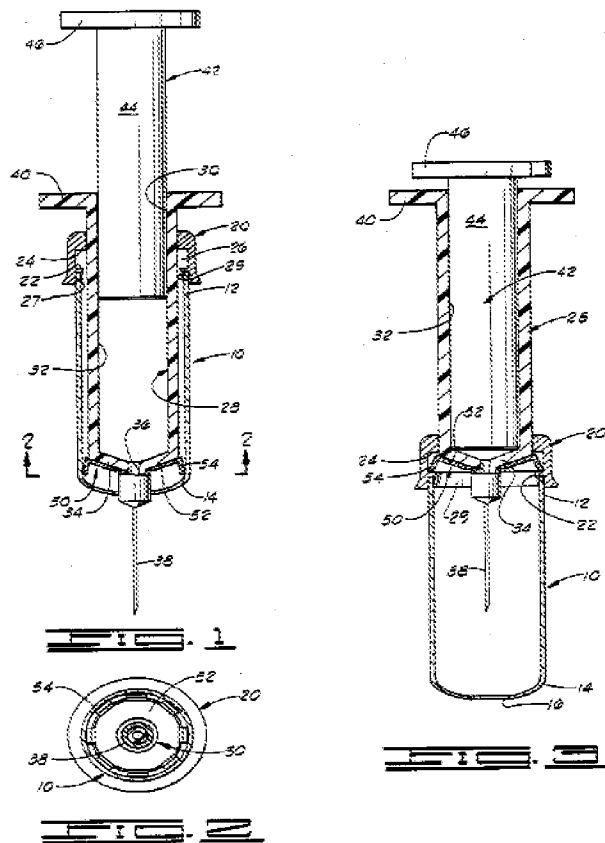
a distal end with an opening through which a needle may extend, and a proximal end with an opening therethrough to permit passage of the medicine cartridge axially into the cavity; a medicine cartridge received in the cavity; a needle extending distally from the distal end of the body; a locking mechanism on the proximal end of the elongate body for preventing disassembly of the syringe device, the locking mechanism comprising a locking detent that contacts a rear surface of the medicine cartridge and prevents proximal movement of the medicine cartridge received in the cavity.

Haber et al. does not disclose a protector case movable relative to the body between rearward and forward positions, and having an open distal end for uncovering and covering, respectively, the needle extending distally from the distal end of the body and cooperating detents on the body and protector case for substantially locking the protector case in the forward position. However, a disposable syringe device with a protector case and cooperating detents is a conventional design as evidenced by the teachings of **Sudnak and Carrell et al.**



The **Sudnak** patent shows in figures 3, 4, 7 and 7A, various protector case designs movable relative to the body between rearward and forward positions, and

having an open distal end for uncovering and covering, respectively, the needle extending distally from the distal end of the body. Additionally, the cited figures also demonstrate the conventionality of cooperating detents (30).



**Carrell et al.** shows in figures 1 and 3, a protector case design movable relative to the body between rearward and forward positions, and having an open distal end for uncovering and covering, respectively, the needle extending distally from the distal end of the body. Notably, this design includes a cooperating detent system to lock the body in the rearward position by the interaction of cooperating detents (50, 54).

Based in the above observations, for a person of ordinary skill in the art, it would have been obvious to modify the elongate body disclosed by Haber et al. with a design that included a protector case and a cooperating detent system, as taught by Sudnak and Carrell et al., in view of the proven conventionality of these enhancements, and moreover, in view of the added safety benefits created by a system that covers the needle and prevents accidental contact with the needle.

***Allowable Subject Matter***

**Claims 1-5 are allowed.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel A. Mendez whose telephone number is 571-272-4962. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Manuel A. Mendez/

Primary Examiner, Art Unit 3763